

REMARKS/ARGUMENTS

I. STATUS OF CLAIMS

Claims 1-30 remain in this application. Claims 1-30 have been rejected.

II. CLAIM REJECTIONS – 35 U.S.C. § 103

The Office Action rejected Claims 1, 3-4, 8-16, 18-19, and 23-30 under 35 U.S.C. § 103(a) as being unpatentable over Beranek et al. (6,226,642) in view of Applicant's admitted prior art. The rejection is respectfully traversed.

Claim 1 appears as follows:

1. A method of optimizing retrieval of electronic documents, comprising the computer-implemented steps of:
  - receiving a first electronic document;
  - identifying one or more symbolic references to other electronic documents within the first electronic document;
  - determining a network address of each of the other electronic documents corresponding to each of the symbolic references;
  - creating and storing a modified copy of the first electronic document in which the network address is substituted for each corresponding symbolic reference;
  - delivering the modified copy of the electronic document in response to all subsequent client requests for the first electronic document.

In particular, the Office Action states:

“As per claims 1, 11-16 and 29-30, Beranek teaches ... identifying one or more symbolic references to other electronic documents within the first electronic document; creating and storing a modified copy of the first electronic document In which a substitution is made for each corresponding symbolic reference (col. 3, lines 27-28; col. 11, lines 3-11; Fig. 7);”

Beranek cannot teach creating and storing a modified copy of the first electronic document in which the network address is substituted for each corresponding symbolic reference as claimed in the invention if, as the Office Action concedes, Beranek does not teach determining a network address of each of the other electronic documents corresponding to each of the symbolic references and the act of substituting involving substituting the network address for each corresponding symbolic address.

Since Beranek does not teach determining a network address of each of the other electronic documents corresponding to each of the symbolic references and the act of substituting involving substituting the network address for each corresponding symbolic address, then Beranek cannot contemplate a modified copy of the first electronic document **in which the network address is substituted for each corresponding symbolic reference**. Beranek therefore does not teach what the Office Action states.

Further, contrary to the Office Action, there is no suggestion in Beranek to combine Beranek with what was summarized on page 2, lines 20-27 in the Specification.

Beranek specifically states that his system is intended for the dynamic control of how information is presented on a browser. Col. 2, lines 19-26 state:

“It is a primary goal of the present invention to dynamically control how information is presented on a browser of a Web system or apparatus that utilizes a television class monitor for displaying Web content.

It is a more particular object of the invention to intercept and re-format a Web document prior to its display on a browser running on a conventional television class display in order to control presentation of that document.”

Col. 2, lines 31-36 also state:

“It is still another object of this invention to provide a mechanism for modifying Web content prior to its display by a browser to thereby mask differences that would otherwise exist when the content is displayed across different types of display systems including, without limitation, a personal computer, a Web appliance, or the like.”

Col. 2, lines 57-62 state:

“Another specific object of this invention is provide a discovery mechanism for use with a Web appliance or system in which the system may discover the characteristics of the various display components therein and then reformat Web content accordingly to enhance the "look and feel" of such content for the discovered characteristics.”

Further, Beranek concentrates on modifying, at the client side, the look and feel of a Web page. Col. 2, lines 42-44 state:

“It is a more general object of this invention modify the "look and feel" of a Web page from the client side of a Web connection.”

Beranek is concerned with the presentation of content. Beranek does not consider, suggest, or identify that there was a need to alleviate the need for DNS resolution and to decrease overall session time and message traffic on the network. With no such needs contemplated in Beranek, there is, therefore, no suggestion to combine Beranek with what was summarized on page 2, lines 20-27 in the Specification. MPEP 2143.01 states:

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

Beranek’s teaching of the dynamic control of how information is presented on a browser has nothing to do with the Office Action’s stated rationale for combination.

Further, it would not have been obvious to one of ordinary skill in the art at the time of the invention to have the substitution made for each symbolic reference taught in the Beranek invention be a network address for symbolic reference substitution because, as stated above, Beranek does not teach or contemplate a modified copy of the first electronic document **in which the network address is substituted for each corresponding symbolic reference**. Therefore, there is no connection between the Office Action’s rationale as to what would have been obvious to one of ordinary skill in the art at the time of the invention and Beranek’s teachings.

It is obvious from the great disparity of Beranek’s teachings and the material summarized on page 2, lines 20-27 in the Specification, that to arrive at the Office

Action's suggested combination was through the use of information gleaned from the present invention. Such use of hindsight is improper.

Therefore, Beranek does not teach or disclose the invention as claimed.

Claim 1 is allowable. Independent Claims 11-16 and 29 are similarly allowable. Claims 3-4, 8-11, 26, and 28 are dependent upon Claim 1 and are allowable. Claims 18-19, 23-25, and 27 are dependent upon Claim 16 and are allowable. Claim 30 is dependent upon Claim 29 and is allowable. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

## II. CLAIM REJECTIONS – 35 U.S.C. § 103

The Office Action rejected Claims 2, 5-7, 17, and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over Beranek et al. (6,226,642) in view of Applicant's admitted prior art as applied to claims 4 above, and further in view of Kavner (6,366,947).

The rejection under 35 USC §103(a) is deemed moot in view of Applicant's comments regarding Claims 1, 11-16 and 29, above. Claims 2 and 5-7 are dependent upon Independent Claim 1. Claims 17 and 20-22 are dependent upon Independent Claim 16. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 USC §103(a).

## III. MISCELLANEOUS

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The Applicants believe that all issues raised in the Office Action have been addressed and that allowance of the pending claims is appropriate. Entry of the amendments herein and further examination on the merits are respectfully requested.


The Examiner is invited to telephone the undersigned at (408) 414-1214 to discuss any issue that may advance prosecution.

No fee is believed to be due specifically in connection with this Reply. To the extent necessary, Applicants petition for an extension of time under 37 C.F.R. § 1.136. The Commissioner is authorized to charge any fee that may be due in connection with this Reply to our Deposit Account No. 50-1302.

Respectfully submitted,

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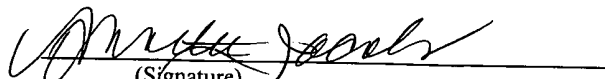
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